

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

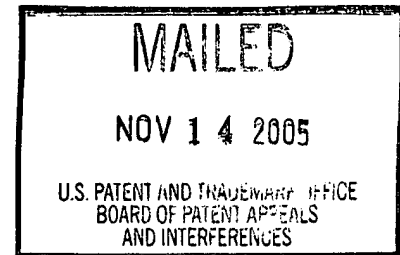
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAMES E. MCSHANE

Appeal No. 2005-2450
Application No. 09/675,938

HEARD: October 20, 2005



Before SCHEINER, GRIMES and GREEN, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 32-42, all the claims remaining in the application.

Claim 32 is representative of the subject matter on appeal:

32. A pressurized aerosol composition for treating foot and shoe disorders, consisting essentially of

- a) micronized zinc oxide;
- b) a propellant for expelling contents of an aerosol container when pressure is released, wherein said propellant is present in an amount of about 40% to about 85%;
- c) about 4 to about 50 percent of a solvent selected from the group consisting of water and C₁ to C₃ alcohols, wherein said pressurized aerosol composition is for treating foot and shoe disorders.

The references relied on by the examiner are:

Nakane et al. (Nakane)	5,122,418	Jun. 16, 1992
Lajoie	5,466,470	Nov. 14, 1995
Lisboa et al. (Lisboa)	5,679,324	Oct. 21, 1997

Claims 32-42 stand rejected under 35 U.S.C. § 103 (a) as unpatentable over Nakane, and also as unpatentable over Lajoie and Lisboa.

We reverse these rejections.

DISCUSSION

Nakane

Nakane describes “composite powder[s] wherein an organic or inorganic core powder is [] completely covered with one or more types of organic, inorganic, or metallic powders having an average particle size one-fifth or less of the average particle size of the [] core powder” (Nakane, Abstract). The composite powders may be incorporated into cosmetics, pharmaceuticals, “quasi-drugs,” sunscreens and deodorants (id., column 9, lines 37-40). Several examples of deodorant powders, lotions and aerosols are described (id., Examples 29-42), including two aerosol deodorant sprays comprising alumina/nylon/micronized zinc oxide or nylon/micronized zinc oxide composite powder and Freon™ propellant (96% by weight) (Examples 35 and 36). None of the exemplified aerosol sprays contains a solvent comprising water or a C₁ to C₃ alcohol (or any other solvent for that matter, unless the propellants can be considered to be solvents).

Nevertheless, the examiner notes that “Nakane further teaches the use of water, [and] C₁ to C₃ alcohols” (Answer, page 4), and concludes that “it would have been obvious to one of ordinary skill in the art . . . to employ a solvent such as water or ethanol, as suggested in Nakane, to perform their own intended use, because . . . selecting such compounds to meet known requirement[s] supports prima facie obviousness” and “[f]urther, it would have been obvious to one of ordinary skill in the art . . . to achieve the desirable concentration of each ingredient by routine experimentation” (id.).

In our opinion, the evidence relied on by the examiner is insufficient to establish a prima facie case of obviousness. Nakane does mention water and various alcohols, along with hundreds of other substances, as possible components of deodorants (see columns 11-12 of Nakane). However, as mentioned above, none of the exemplified aerosol deodorants includes water or alcohol, and the examiner has not identified any reason to select either of these particular components from the hundreds of possible additional components listed, nor has the examiner explained what “their own intended use” would be in Nakane’s aerosol formulations.

The fact that the prior art could have been modified in a manner consistent with appellant’s claims would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). On this record, however, the only reason or suggestion to combine micronized zinc oxide, a propellant and a solvent in the manner required by the claims comes from appellant’s specification. “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As explained in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

. . . to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted]

In other words, “there still must be evidence that ‘a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art []

for combination in the manner claimed.” Ecolochem Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075-76 (Fed. Cir. 2000).

On this record, we find that the examiner has not provided evidence sufficient to establish that claims 32-42 are unpatentable over Nakane. Accordingly, the rejection of the claims under 35 U.S.C. § 103 is reversed.

Lajoie and Lisboa

Claims 32-42 also stand rejected as unpatentable over the combined disclosures of Lajoie and Lisboa. Lajoie describes a free-flowing “co-micronized composition” comprising a bicarbonate salt and a crystalline inorganic compound, wherein the crystalline inorganic compound can be micronized zinc oxide.

Lisboa describes aerosol foamable fragrance compositions comprising a surfactant, a propellant, fragrance and a thickener “wherein the ratio of the surfactant to propellant is from about 1:1 to about 1:10” (Lisboa, column 1, lines 65-66), and “[t]he level of the propellant used in the [compositions] is from about 2% to about 8%” (id., column 2, lines 43-44). The compositions may further comprise “cosmetically active ingredients” such as coolants, moisturizers, emollients and sunscreens – including zinc oxide (not, however, described as micronized) (id., column 6, line 14 to column 8, line 17). According to Lisboa, aerosol compositions have been “gaining wide appeal among both men and women” (id., column 1, lines 21-22).

In the examiner’s opinion, “it would have been obvious to one of ordinary skill in the art . . . to add a propellant, such as those taught by Lisboa, to the compositions of Lajoie and formulate an aerosol topical delivery system of Lajoie’s compositions, because one of ordinary skill in the art would have had a reasonable expectation to succeed in formulating aerosolized formulations that are easy to use and are more appealing to the general consumer[]” (Answer, pages 5-6).

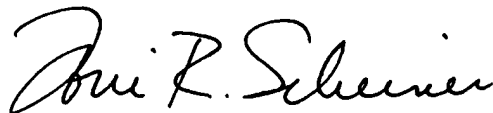
Even if we accept the premise that it would have been obvious to have aerosolized Lajoie's micronized zinc oxide because consumers find aerosols appealing, the examiner's rejection does not begin to address the requirement that a propellant is "present in an amount of about 40% to about 85%" in the claimed micronized zinc oxide aerosols, together with about 4% to about 50% water or alcohol. Again, the fact that the prior art could have been modified in a manner consistent with appellant's claims would not have made the modification obvious unless the prior art suggested the desirability of the modification (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Here again, the only reason or suggestion to combine micronized zinc oxide, a propellant and a solvent in the manner required by the claims comes from appellant's specification.

On this record, we find that the examiner has not provided evidence sufficient to establish that claims 32-42 are unpatentable over the combined teachings of Lajoie and Lisboa. Accordingly, the rejection of the claims under 35 U.S.C. § 103 is reversed.

CONCLUSION

On this record, we find that the examiner has not provided evidence sufficient to establish that claims 32-42 are unpatentable over Nakane, or over the combined teachings of Lajoie and Lisboa. Accordingly, both rejections of the claims under 35 U.S.C. § 103 are reversed.

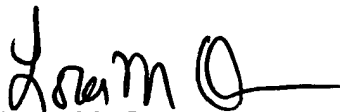
REVERSED



Toni R. Scheiner
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge



Lora M. Green
Administrative Patent Judge

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